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EXAMINER

PORTER, RACHEL L

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/444,660
Filing Date: November 22, 1999
Appellant(s): PETRUS, EDWARD J.

Edward J. Petrus
Pro se Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 11/11/2005 appealing from the Office action mailed 12/22/2004.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the examiner, which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

Appeal 2003-2002 was filed on April 4, 2003 for the instant application, 09/444,660.

On appeal, claims 1-5 were rejected only under 35 USC §103. In the BPAI decision, the Examiner's art rejection was not sustained. However, the previous decision also states the following:

"It should be understood, however, that our decision in this regard rests solely on the indefiniteness of the claimed subject matter and does not reflect on the adequacy of the prior art evidence applied in support of the §103 rejection."

(see pages 3-4 of BPAI decision mailed 7/21/04)

Pursuant to 37 C.F.R. §1.196(b) the BPAI decision, mailed 7/21/04, introduced new grounds of rejection under 35 U.S.C. §112, 1st and 2nd paragraphs, as claims 1-5

were found to be indefinite, and it was determined that the specification lacked adequate written description of the claimed invention.

(3) Status of Claims

The statement of the status of claims contained in the brief is incorrect. A correct statement of the status of the claims is as follows:

This appeal involves claims 1-5.

Claim 1 has been amended subsequent to the final rejection.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is incorrect.

The amendment after final rejection filed on 2/8/05 has been entered. It was determined that the amendments provided in the After-Final response (filed 2/8/05) did not overcome the written description rejection provided under 35 U.S.C. 112, 1st paragraph.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows:

- (A) Whether claims 1-5 comply with the adequate written description requirements of under 35 U.S.C. 112, first paragraph.
- (B) Whether claims 1-5 are patentable over Summerell et al (USPN 5,937,387) in view of Riley (USPN 5,976,568)

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,937,387	SUMMERELL et al	8-1999
5,976,568	RILEY	11-1999

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

(A) Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-5 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In the decision mailed 7/21/04, the BPAI rejected claims 1-5 for failing to provide adequate written description for the step of adjusting for differences compared to the optimal health profile.

The Appellant amended claim 1 to recite a step of "comparing the individual's health information to standardized health profile based on age, physical activity....to achieve optimal health and wellness."

However, it is respectfully submitted that the originally filed disclosure does not describe, "comparing in the individual's health's information to standardized profiles... to achieve optimal health and wellness." Therefore, the amendment is not sufficient to overcome the rejection under 35 U.S.C. 112, first paragraph, for failing to comply with the written description requirement.

In particular, there are passages directed to comparing "the individual's health information with standardized profiles..." (see page 4, lines 20-21 of the instant specification-received 6/24/2002) and a comparison "with past profiles to determine any changes in nurtitional (*sic*) status." (See page 5, lines 17-18 of the specification-received 6/24/2002) However, original disclosure lacks an adequate written description of the claimed invention. In particular, the original disclosure does not contain sufficient

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description and detail to allow one of ordinary skill in the art to understand whether or not the Appellant had possession of an invention that compares individual health information to standardized profiles in a manner which achieves *optimal health and wellness* or that the claimed invention generates a dietary supplement profile that achieves *optimal health and wellness*.

Claims 2-5 inherit the deficiencies of claim 1 through dependency and are also rejected.

NOTE: In light of the 112 problems, the examiner is interpreting the claims and applying prior art as best as possible using these interpretations. These interpretations of claim language are for examination purposes only.

(B) Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-5 are rejected under 35 U.S.C. §103(a) as being unpatentable over Summerell et al (U.S. Patent No. 5,937,387) in view of Riley (U.S. Patent No. 5,976,568)

In reference to claim 1, Summerell et al teach a method for creating a dietary supplement profile for an individual comprising:

- completing a health questionnaire by an individual; (Figures 4-6; col. 9, lines 15-31)
- comparing the information gathered from the questionnaire to health standard information for a person of the individual's age and health history background (col. 8, line 30-41; line 53-col. 9, line 14; col. 11, lines 18-29)
- comparing the individual's health the information to standardized profiles based on age, sex (gender), physical activity (e.g. energy expenditure), dietary habits, and past medical history (col. 8, line 30-41; line 53-col. 9, line 14; col. 11, lines 18-29; Table 1)
- generating a computer-implemented dietary supplement profile listing vitamins and minerals based on the individual's health information (Figures 19-28)

Summerell et al teach a method and system for providing a dietary supplement profile for an individual in which information from an individual's questionnaire is compared to health standard information based on individuals of comparable age, gender and other health risks including physical activity. (col. 11, lines 18-29) As per the recitation that the comparisons are performed to achieve optimal health and wellness, Summerell discloses a wellness factor array scale that outlines "optimal physiological ages" that can be achieved with consumption of "optimal levels" of certain nutrients and with changes to various other health factors. (Table 1)

Summerell does not specifically teach that the health standard information (i.e. risk factor data) to which individual's questionnaire information is compared includes standards stored in a *database*, but Summerell does disclose that a plurality of profile information is stored in various forms in the system. (col. 8, lines 8-60) At the time of the Appellant's invention, it would have been obvious to one of ordinary skill in the art to modify the system/method of Summerell to compare the individual's questionnaire information to standards stored in a database. One would have been motivated to include this feature facilitate data retrieval and health data comparisons and to better assist the user in setting and progressing toward tailored fitness goals that improve overall wellness, as suggested by Summerell. (col. 6, lines 36-52)

Summerell teaches a system/method that obtains individual health data and compares this data to health standard information as explained above. Summerell also discloses a system/method for providing a listing of nutritional/dietary supplements and suggested adjustments to lifestyle habits based on the system's comparison to health standard information (Figures 18-25). However, Summerell does not expressly disclose providing a listing of herbs, enzymes, and amino acids.

Riley teaches a method that compares the individual's health profile to a standard health profile, adjusting for differences and generates a dietary supplement profile based on the individual's health information. (col. 7, line 33-col. 8, line 9; col. 17, lines 30-40, col. 21, lines 35-40)). Furthermore, Riley teaches a method in which the dietary supplement plan includes vitamins, minerals, and herbs. (Table 3)

Summerell and Riley do not expressly disclose that the dietary profile(s) also include(s) enzymes and amino acids, but Riley does teach that the supplement profiles may include other dietary or nutritional compounds. (col. 21, lines 35-40; col. 22, lines 31-38) At the time of the Appellant's invention, it would have been obvious to one of ordinary skill in the art to further modify the system of Summerell in view of Riley to include amino acids and enzymes in the dietary supplement plan for optimal health. As suggested by Riley, one would have been motivated to do this to further ensure adequate intake of nutrients needed for disease prevention and to optimize wellness for individuals with varying lifestyle factors and states of health. (col. 7, lines 33-39; line 65-col. 8, line 9)

In reference to claim 2, Summerell et al and Riley teach the method of providing a dietary supplement profile of claim 1 as explained in the rejection of claim 1. Summerell et al further teach a method wherein the step of comparing further comprises the adding information provided from a physical examination. (col. 5, lines 62-67) A physician can input test result data (e.g. the individual's blood pressure) into the system. The questionnaire information and physical exam information are compared to health standard data (i.e. health profile data), and these data are used in determining the individual's wellness measurement and making health recommendations (i.e. dietary supplement profile). (col. 5, lines 62-67; see also Table 2; Figures 18-25, esp. figure 24—blood pressure recommendations)

In reference to claim 3, Summerell et al and Riley teach the method of providing a dietary supplement profile of claim 1 as explained in the rejection of claim 1.

Summerell et al further teach a method wherein the step of comparing further comprises adding information provided by laboratory studies. (col. 3, lines 19-39, col. 5, lines 62-67) The method disclosed by Summerell et al assesses individual wellness based on several risk factors, health parameters, and test results, including total and HDL cholesterol levels and white blood cell counts. It is respectfully these data items are results that are by laboratory studies. (i.e. blood work/ blood counts.) The questionnaire information and laboratory information are compared to health standard data (i.e. health profile data), and these data are used in determining the individual's wellness measurement and making health recommendations (i.e. dietary supplement profile). (col. 3, lines 19-39, col. 5, lines 62-67; see also Table 2; Figures 18-25, esp. figure 23—cholesterol level recommendations)

In reference to claim 4, Summerell et al and Riley teach the method of providing a dietary supplement profile of claim 1 as explained in the rejection of claim 1. Summerell et al teach a method that also includes adding a list of commercially available products that provide the dietary supplements listed in an optimal health profile. (Figures 24-25) In addition to providing nutritional recommendations, the output of the Summerell system also details which products (e.g. fruits, vegetables, artificial vitamin supplements) provide suggested nutrients. It is respectfully submitted the listed food products and artificial nutritional supplements are commercially available products.

Moreover, the products included in the list provide nutrients that are included for an optimal health profile (e.g. vitamin C, vitamin E) (as per Riley reference: see Table 3)

In reference to claim 5, Summerell et al and Riley teach the method of providing a dietary supplement profile of claim 1 as explained in the rejection of claim 1.

Summerell et al also teach a method wherein the dietary supplement profile also includes adding recommendations for weight management. (i.e. a weight management plan) (Figure 24). The sample "recommendation details" in the figure suggest a weight loss target for individuals with certain health problems (e.g. high blood pressure) and also explain the health benefits of weight loss and weight maintenance.

(10) Response to Argument

(A) Claims 1-5 were also rejected under 35 U.S.C. 112, 1st paragraph. The Appellant did not address this rejection in the Appeal Brief filed on 11/11/05, and it was determined that the amendments provided in the After-Final response (filed 2/8/05) did not overcome the written description rejection provided under 35 U.S.C. 112, 1st paragraph.

Appellant was advised to provide arguments regarding the 112, 1st paragraph rejection in the Non-Compliant Appeal Brief Notice mailed 7/29/2005 and in a telephonic interview conducted on 11/9/2005.

(B) Appellant argues that Summerell should not be used because modifications made to the Summerell reference in the rejection destroy its intended purpose and function.

In response, it is respectfully submitted that the purpose of the Summerell reference is in fact to develop a customized wellness plan, and to allow the user to implement the customized wellness plan. (See Abstract) The combination of Summerell and Riley in the applied rejection does not destroy the purpose of the Summerell in providing a customized wellness plan, but in fact adds to the system's ability to provide personalized/customized suggestions to users.

(C) Appellant argues how the claimed invention distinguishes over Summerell and Riley individually.

In response to Appellant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In this case, the combination of Summerell et al in view of Riley has been provided to address the limitations of claim 1. Summerell et al teach a system for providing a personalized health and fitness profile for an individual. The system also generates health recommendations for the user listing suggestions on nutritional supplements (e.g. vitamins and minerals) to take to improve the user's health. (i.e.

dietary supplement plan) (See figures 18-25, especially 22-25) For instance, in Figures 23-25, the Recommendation Details provide information on dietary supplements, which is addressed to a specific individual user of the system (i.e. Bob Barker). Insofar as the recommendations provided by the system and method of Summerell include recommendations for vitamins and minerals from natural and/or synthetic sources (Figure 24), the Examiner submits that the system generates a dietary supplement plan.

The secondary reference, Riley, was relied upon to teach generating a dietary supplement profile that includes vitamins, minerals, and herbs based on the individual's health information. (col. 7, line 33-col. 8, line 9; col. 17, lines 30-40, col. 21, lines 35-40). The dietary supplement plan in the system/method of Riley compensates for nutrients that an individual may require due to various lifestyle factors or risk factors and provides vitamins, minerals, and herbs. (Table 3)

Riley does not expressly disclose that the dietary plan/profile(s) also include(s) enzymes and amino acids, but does teach that the supplement profiles may include other dietary or nutritional compounds. (col. 21, lines 35-40; col. 22, lines 31-38)

However, the test for obviousness is not that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). At the time of the Appellant's invention, it would have been obvious to one of ordinary skill in the art to further modify the system of Summerell in view of Riley to include amino acids and enzymes in the dietary supplement plan for an optimal health profile. As suggested by

Riley, one would have been motivated to do this to further ensure adequate intake of nutrients needed for disease prevention and to optimize wellness for individuals with varying lifestyle factors and states of health. (col. 7, lines 33-39; line 65-col. 8, line 9).

(D) Appellant argues that the Summerell and Riley combination is improper because Riley teaches away from the Appellant's invention.

In response, it is noted that the passages upon which the Appellant relies, namely col. 2, lines 42-49 and lines 62-66, are part of the "Background" information and do not reflect the teachings disclosed by Riley throughout the reference as a whole. In their proper context, these passages have been provided to identify problems that existed regarding nutritional supplementation at the time of the Riley invention. Simply stated, these passages describe long-felt needs within the art that Riley intended to address with the disclosed invention, and are not a description of the Riley invention, *per se*.

The Appellant appears to view the applied references, separately, and further fails to consider the teaching and suggestions of the Riley reference, as detailed in the Final Rejection (mailed 9/11/2002). Contrary to the Appellant's assertion that the reference teaches away from the Appellant's invention, the Riley reference in particular, suggests that a principle purpose of the invention is to fulfill the need for "... a nutritional system which supplies the right amount of micronutrients at the right time to help prevent the problems commonly seen with vitamin supplementation . . ." (col. 4,

lines 32-47). As such, it is respectfully submitted that the Appellant's reliance upon the decisions in *United States v. Adams* and *In re Fine* are moot.

The Examiner recognizes that references cannot be arbitrarily altered or modified and that there must be some reason why one skilled in the art would be motivated to make the proposed modifications. While the Examiner acknowledges that the motivation or suggestion to make modifications must be articulated, it is respectfully submitted that there is no requirement that the motivation to make modifications must be expressly articulated within the references themselves.

In this case, however, the Examiner respectfully notes that the motivations to combine the applied references used for the art rejection of claim 1 are accompanied by select portions of the reference(s) that support the motivations. As such, it is not seen that the Examiner's combination of references is unsupported by the applied prior art of record. Rather, it is respectfully submitted that an explanation based on the logic and scientific reasoning of one ordinarily skilled in the art at the time of the invention that support a holding of obviousness has been adequately provided by the motivations and reasons indicated by the Examiner.

(E) The Appellant that claim 4 includes limitations, which distinguish the instant invention over the prior art of record.

In response to the Appellant's argument that the reference(s) fail to show certain features of Appellant's invention, it is noted that the features upon which Appellant relies (i.e. "computer controlled feedback loops by which the consequences of an event send

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back data that in turn modify that event in the future”) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

It is respectfully submitted that the Appellant fails to properly consider the vast breadth of the chosen claim language, and apparently relies upon features described only in portions of the specification in an attempt to distinguish the invention over the prior art. The Examiner must search for and consider prior art based on how it reads on the invention *as the invention is claimed*.

While the Examiner acknowledges that the prior art of record may or may not include each limitation of the invention *as disclosed in the Appellant's specification*, Examiner submits the claimed limitations of the invention have been shown to be either fully disclosed or obvious over the art of record as explained the previous Office Actions provided to the Appellant.

(F) Appellant argues that the Examiner changed the grounds of rejection from a 102 to a 103 improperly and that Riley was only introduced after the first Non-Final Rejection (mailed 3/15/2002)

The Appellant's arguments regarding rejections under 35 U.S.C. §102 are moot since none of the claims currently stand rejected under 35 U.S.C. §102 or stood rejected under 35 U.S.C. §102 in the Final rejection mailed 12/22/04.

Previous rejections under 35 U.S.C. §102 rejections were withdrawn and new grounds of rejection have been introduced as necessitated by the Appellant's substantial amendments to the claims throughout prosecution of the application (e.g. in particular on 6/11/02 and on 6/24/02).

As such, it is respectfully submitted that the Appellant's reliance upon the *Carella v. Starlight Archery and Pro Lines Co.* decision on page 9 of the 11/11/05 Appeal Brief is immaterial to the issues at hand.

Moreover, a petition regarding this issue has already been decided. The Appellant's arguments regarding the propriety of new grounds of rejection in the Final Rejection mailed 9/11/02 have been fully considered and addressed in detail in the Advisory Action (mailed 11/18/2002) and in the Response to the Appellant's Petition under 37 C.F.R. 1.181 (mailed 3/14/03)

(G) The Appellant alleges that the issues of rejection and motivations for the applied combinations are vague, and that "the rejection by the examiner could be viewed as void for vagueness." The Appellant further argues that no clear issue has been developed between the Examiner and the Appellant.

The Appellant's assessment of the issues of rejection and the assertion that no clear issue regarding the claim rejections has been communicated is incorrect. The Final Rejection (mailed 9/11/02) was 13 pages in length and provided specific reasons for the objections to the amendments filed 6/11/02 & 6/24/02, as well as detailed rejections under 35 U.S.C. 112, 2nd paragraph and 35 U.S.C. 103. The Examiner has

also addressed the Appellant's arguments in the Final Rejection and in the Advisory Action mailed 11/18/02 in an attempt to further assist Appellant in understanding the Examiner's interpretation of the prior art as applied to the claimed invention. Furthermore, in a telephonic interview dated June 2002, the Appellant never indicated that there was any vagueness or a lack of clear issues in the case.

In fact, the Appellant's After Final response, received 10/22/02, does not indicate a lack of clarity in the Examiner's objections to the specification or rejections of the pending claims. At each stage of prosecution, the Examiner has provided detailed explanations of the formal issues and grounds of rejections that stand against the pending claims. Any changes made regarding the Examiner's positions, formal issues, and the grounds of rejections have been made only in response to amendments and corrections made to the specification and to the claims by the Appellant.

Moreover, the Examiner and SPE had several additional telephonic interviews with the Appellant since the previous BPAI decision, to attempt to resolve any new questions or issues. It is respectfully submitted the Appellant simply disagrees with the Examiner's positions, which have been clearly outlined and explained in detail in each communication sent from the Patent Office with regard to the instant application.

(11) Related Proceeding(s) Appendix

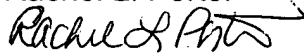
Copies of the court or Board decision(s) identified in the Related Appeals and Interferences section of this examiner's answer are provided herein.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

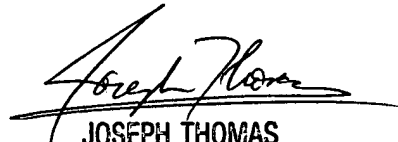
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